UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,783	01/24/2000	Richard C. Johnson	ORCL5628	7640

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EXAMINER
GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _10 May 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-4,7-10,13-16 and 18-27_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-4,7-10,13-16 and 18-27_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _08172004_.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible

for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has

been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37

CFR 1.114. Applicant's submission filed on 5/10/04 has been entered.

Response to Amendment

2.   In the amendment filed 5/10/04, the following has occurred: claims 5-6, 11-12, 17, and

28 have been canceled and claims 1, 7, 13, 18, and 27 have been amended. Now, claims 1-4,

7-10, 13-16, and 18-27 are presented for examination.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

4.   Claims 1-4, 7-10, 16-16, and 27 are rejected under 35 U.S.C. 102(e) as being

anticipated by Stolfo et al., U.S. Patent Publication No. 2004/0002903.

5.   As per claim 1, Stolfo teaches a method for a bank to enable anonymous shipment of a

package containing goods purchased by a customer from a vendor for delivery to an address

unkown to the vendor, the customer maintaining an account at the bank, the bank storing an

address associated with the customer's account, the bank carrying out the steps of: receiving an

electronic draft from the customer for the purchase of the goods along with a request for a

package code for the package (see page 16, paragraphs 186-187); authenticating the customer

and guaranteeing payment to the vendor on the draft only if the customer is authenticated and

bank-imposed restrictions are met (see page 17, paragraphs 190-191); if the customer is

authenticated and bank-imposed restrictions are met, sending the package code to the vendor,

the package code being devoid of delivery address information (see page 17, paragraph 191);

and sending a shipping identifier and the address associated with the customer's account at the

bank to the shipper, whereby the shipper, after picking up the package for shipment from the

vendor, matches the package code sent to the vendor with the shipping identifier and identifies

the associated address as the delivery address of the package (see page 17, paragraph 194

and 198).

6.   As per claim 2, Stolfo teaches the method of claim 1 as described above, wherein the

package code includes at least one of a code number and machine-readable indicia expressing

the code number (see page 16, paragraphs 187-188).

7.   As per claim 3, Stolfo teaches the method of claim 1 as described above, wherein the

received request includes at least one of a request for authentication and an electronic draft for

payment of at least one of the purchased goods and a shipping charge (see page 16, paragraph

189).

8.   As per claim 4, Stolfo teaches the method of claim 1 as described above, wherein the

receiving and sending steps are performed over a computer network (see Figure 3).

9.   Claims 7-10 and 13-16 recite substantially similar limitations from the shipper and

vendor perspective to those of claims 1-4 from the bank perspective and, as such, are rejected

for similar reasons as given above.

10.   Claim 27 recites substantially similar limitations to claim 1 with the added limitations that

the vendor forwards the goods and package code to a forwarding electronic address and then

retrieved forwarded goods are delivered to a stored electronic delivery address. Stolfo further

teaches that a vendor can forward the goods and package code to a proxy shipping depot

address, at which point the goods are delivered to a stored electronic delivery address (see

page 17, paragraphs 193 and 194).

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy,

U.S. Patent No. 6,260,024 in view of Heiden et al., U.S. Patent No. 6,055,520.

13.   As per claim 18, Shkedy teaches a method for a bank to enable a customer to

purchase an item from a vendor via an electronic draft for delivery to an address comprising the

steps of: storing an encrypted unique identifier for the customer, the encrypted unique identifier

being linked to the customer's personal and financial information stored in the bank, including

the delivery address (Shkedy; col. 10, lines 1-10 and col. 21, lines 24-44, and col. 25, lines 31-

61); authenticating the customer having caused a draft to be executed for payment of at least

one of a purchase price of the item and a shipping cost by encrypting at least a portion of an

identification data provided by the customer and successfully matching the encrypted

identification data with the stored encrypted unique identifier (Shkedy; col. 21, lines 25-44);

retrieving at least the authenticated customer's financial information (Shkedy; col. 5, line 61 -col.

6, line 3); honoring a draft presented by the vendor for payment of the item only when the

customer is successfully authenticated by the bank and bank-imposted restrictions are satisfied

(Shkedy; col. 6, lines 29-39).

14.   Shkedy fails to expressly teach retrieving at least the authenticated customer's delivery

address, generating a package code for the item, the generated package code being devoid of

delivery address information, associating the retrieved delivery address to the generated

package code, sending the package code to the vendor, the vendor affixing the package code

to the package, and whereby the shipper picks up the item from the vendor, and prints out a

shipping label for the package, a delivery address on the label being that customer address

linked to a package code stored in the shipper database that matches the package code affixed

to the package. However, this feature is old and well known in the art, as evidenced by Heiden's

teachings with regards to retrieving at least the authenticated customer's delivery address

(Heiden; col. 6, lines 35-58), generating a package code for the item, the generated package

code being devoid of delivery address information, associating the retrieved delivery address to

the generated package code (Heiden; col. 7, lines 1-24), sending the package code to the

vendor, the vendor affixing the package code to the package (Heiden; col. 7, lines 16-24), and

whereby the shipper picks up the item from the vendor, and prints out a shipping label for the

package, a delivery address on the label being that customer address linked to a package code

stored in the shipper database that matches the package code affixed to the package (Heiden;

col. 6, lines 35-67). It is respectfully submitted, that it would have been obvious, to one having

ordinary skill in the art at the time the invention was made, to expand the system taught by

Shkedy with Heiden's teaching with regards to these limitations, with the motivation of

producing package labels without disclosing the delivery address to the party producing the

package (Heiden; col. 1, lines 44-48). Shkedy and Heiden collectively fail to expressly teaching

sending the package code and associated delivery address to a shipper for storage in a shipper database. However since the combined system of Shkedy and Heiden clearly teach a shipper sending a package having an associated package code and delivery address (Heiden; col. 6, lines 59-67) and a database containing package codes and delivery addresses (Shkedy; col. 10, lines 1-10, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Shkedy and Heiden to send the package code and associated delivery address to a shipper for storage in a shipper database, with the motivation of providing the delivery address of where the package should be sent to the shipper.

15.   As per claim 19, Shkedy teaches the identification data includes at least one of an ID and a password, the password being known to the bank only in encrypted form, biometric data and a digital certificate (Shkedy; col. 4, line 66-col. 5, line 7).

16.   As per claim 20, Shkedy teaches the customers' encrypted unique identifier, personal and financial information are stored in a data structure managed by a Directory software controlled by the bank (Shkedy; col. 9, lines 33-47).

17.   As per claim 21, Shkedy and Heiden collectively fail to expressly teach wherein the package code and the linked customer address are replicated in the shipper address via Light Weight Directory Address Protocol (LDAPI). However, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Shkedy and Heiden with regards to this limitation, with the motivation of preventing the loss of data by proving a backup up copy with a commonly known method of accessing data.

18.   As per claim 22, Shkedy and Heiden collectively fail to expressly teach at least portion of the shipper database is replicated in a portable electronic device equipped with a package

scanner and a shipping label printer. However, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Shkedy and Heiden with regards to this limitation, with the motivation of enabling the matching to be done remotely.

19.   As per claim 23, Shkedy fails to expressly teach wherein the package code includes at least one of a code number and machine-readable indicia representing the code number. However, this feature is old and well known in the art, as evidenced by Heiden's teachings with regards to wherein the package code includes at least one of a code number and machine-readable indicia representing the code number (Heiden; col. 7, lines 9-16 and 22-24). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Shkedy with Heiden's teaching with regards to this limitation, with the motivation of producing package labels without disclosing the delivery address to the party producing the package (Heiden; col. 1, lines 44-48).

20.   As per claims 24 and 25, Shkedy teaches wherein the authenticating and sending steps are performed over a computer network that includes the Internet (Heiden; col. 8, lines 55-65).

21.   As per claim 26, Shkedy and Heiden collectively fail to expressly teach wherein the customer is a business. However, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Shkedy and Heiden with regards to this limitation, with the motivation of enabling the system to work with the diverse set of customers in the market for purchasing products and services.

Response to Arguments

22.   In the remarks filed 5/10/04, Applicant argues in substance that Shkedy and Heiden fail to teach certain features recited in claims 1-4, 7-10, 13-16, and 27; and that Shekedy and Heiden are not properly combinable and fail to tech the method of claim 18.

23.   It is first respectfully submitted that the Examiner has applied a new grounds of rejection with respect to claims 1-4, 7-10, 13-16. Therefore, these arguments are now moot in view of the rejections detailed above.

24.   Furthermore, it is respectfully submitted that, with respect to claim 18, the teachings of Heiden have only been relied upon by the Examiner to teach the features of retrieving at least the authenticated customer's delivery address, generating a package code for the item, the generated package code being devoid of delivery address information, associating the retrieved delivery address to the generated package code, sending the package code to the vendor, the vendor affixing the package code to the package, and whereby the shipper picks up the item from the vendor, and prints out a shipping label for the package, a delivery address on the label being that customer address linked to a package code stored in the shipper database that matches the package code affixed to the package. Therefore, Applicant's remarks with respect to where the two references store customer information is not relevant to actual rejections recited above. Additionally, Applicant's have failed to point to specific limitations recited in the claims that the combination of references fails to teach other than a genera assertion that shipment is not "anonymous" in such a combination. Therefore, this argument is not found to be persuasive.
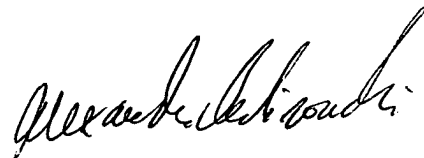
Conclusion

25.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner

can normally be reached on Monday-Friday 8am-5:30pm.

26.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

27.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CLG
8/19/04

ALEXANDER KALINOWSKI
PRIMARY EXAMINER